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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,683	01/18/2002	Roy J. Walker	1112431-0351	3749

7470 7590 07/24/2003
WHITE & CASE LLP
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

KING, BRADLEY T

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 07/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/052,683

Applicant(s)

WALKER, ROY J.

Examin r

Bradley T King

Art Unit

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-- The MAILING DATE of this c mmunication appears n the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/5/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites "the burnished finish is a street car brake pad burnished finish". It is unclear what qualifies as a "street car burnished finish".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 10, 12-13, and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al (US# 5979615).

Thompson et al discloses all the limitations of the instant claims with exception to the specific friction material. Thompson et al discloses the use of a carbon based material due to its consistent friction properties and further discloses the desirability of friction materials with high friction coefficients and consistent friction characteristics in

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elevator brake application. It is well known in the art to select friction compounds through routine calculation or experimentation to provide a brake element suitable for a given application. The instant specification indicates that carbon metallic friction materials are known in the art (page 3, lines 2-4 indicate the use of standard materials). It would have been obvious to one of ordinary skill in the art at the time the invention was made to select a carbon metallic material as part of routine material selection to provide consistent braking, thereby increasing the safety of the elevator brake.

Regarding claims 2, and 16, Thompson et al lack the disclosure of the claimed equation which describes the coefficient of friction. However, the equation appears to be a characterization of the coefficient of friction for the carbon metallic material. Selection of the same known material will inherently be described by the equation.

Claims 3-9 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al as applied to claim 10 above, and further in view of Chwastiak et al (US# 5693402).

Thompson et al, as modified above, discloses all the limitations of the instant claims with exception to a burnished brake pad finish. Chwastiak et al teach a method of laser burnishing a brake pad to decrease the brake-in period of the pad so that the pad exhibits a more stable friction coefficient. It would have been obvious to one of ordinary skill in the art at the time the invention was made to laser burnish the pads of Thompson et al as taught by Chwastiak et al to provide a more stable friction coefficient, thereby increasing the consistency and safety of the brake.

Response to Arguments

Applicant's arguments filed 5/5/03 have been fully considered but they are not persuasive.

Regarding claim 7, it is maintained that the term "street car pad burnished finish" is indefinite. There does not appear to be any specific finish or treatment known in the art to correspond to this term. Also note column 1, lines 15-50 of Chwastiak et al (US#5693402) which discusses several conventional methods of burnishing or pre-burnishing street car brake pads including one in which the pads are burnished through a series of hard stops after they are installed. The reference also discusses laser burnishing for street car pads, but the instant disclosure appears to indicate that laser burnishing is different from a street car brake pad burnished finish. It is maintained that the term does not carry any art recognized ordinary meaning, and therefore renders the claim indefinite.

Regarding the modification of Thompson, it is maintained the rejection is proper. While the reference may teach away from a cast iron pad surface, one of ordinary skill in the art would not find this teaching applicable to all compositions having a metallic component. One of ordinary skill in the art appreciates that materials in friction compositions are selected such that they collectively provide the desired friction characteristics. A suggestion that a friction element made only of the specific material gray cast iron is not suitable for high speed brake applications would not discourage one from utilizing compositions that may include metallic materials. Also note that gray

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cast iron is only one type of material from the broader group of metallic materials.

Thompson further suggests the need to use alternative friction materials which provide low wear and consistent high friction (column 1, lines 47-51).

Regarding applicant's arguments that the rejection is based on the "obvious to try standard", it is noted that Thompson identifies the necessary friction characteristics for high speed elevator brakes and the need to utilize alternative friction materials. Further motivation is found in the knowledge of one of ordinary skill in the art as the selection of known materials based on the required operational characteristics is considered a routine and necessary step in design. It is maintained that it would have been obvious to one of ordinary skill in the art at the time the invention was made to select a known friction material on the basis of its suitability for the intended use and thereby provide the required low wear and consistent high friction properties for proper operation. Also note *In re Leshin*, 227 F.2d 197, 125 USPQ 416.

Regarding the combination of Thompson and Chwastiak et al, it is maintained that the rejection is proper. Chwastiak et al teaches a method of burnishing brake pads and further provides the specific example of automotive brake pads, but there is no indication that the teachings are only applicable to automotive brake pads. Chwastiak et al and Thompson are linked by the common goal of providing consistent friction levels in brake elements. It is maintained that the rejection is proper.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley T King whose telephone number is (703) 308-8346. The examiner can normally be reached on 11:00-7:30 M-F.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

BTK
July 23, 2003


JACK LAVINDER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3300